# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/707,140 | 11/06/2000 | Outi Aho | 460-009944-US(PAR) | 8800 |

| | | | EXAMINER |
|---|---|---|---|
| 2512 | 7590 | 08/05/2004 | VU, THONG H |

PERMAN & GREEN
425 POST ROAD
FAIRFIELD, CT 06824

| ART UNIT | PAPER NUMBER |
|---|---|
| 2142 | |

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *14 June 2004*.

2a)☐ This action is **FINAL.**    2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-52* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All    b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

1.    Claims 1-52 are pending.

## Response to Arguments

2.    Applicant's arguments with respect to claims 1-52 have been considered but are

moot in view of the new ground(s) of rejection.

## Double Patenting

3.    The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.  See *In re Goodman*, 11
F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225
USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA
1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*,
418 F.2d 528, 163 USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be
used to overcome an actual or provisional rejection based on a nonstatutory double
patenting ground provided the conflicting application or patent is shown to be commonly
owned with this application.  See 37 CFR 1.130(b).
        Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer.  A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

        Claims 1-52 are rejected under the judicially created doctrine of double patenting

over claims 1-16 of U. S. Patent No. 6,693,915 B1 since the claims, if allowed, would

improperly extend the "right to exclude" already granted in the patent.

        The subject matter claimed in the instant application is fully disclosed in the

patent and is covered by the patent since the patent and the application are claiming

common subject matter, as follows:

**Patent '915:**

(Claim 1) A method in a wireless data transmission system which comprises wireless
terminals, at least a first access point and a first access point controller, and a second
access point and a second access point controller, in which method first data frames
and second data frames are established, the controller of the first access point controls

the transmission and reception of the first data frames between the first access point and the wireless terminals communicating with the first access point, wherein said first data frames are used in the data transmission between the first access point and the wireless terminals communicating with the first access point, the controller of the second access point controls the transmission and reception of the second data frames between the second access point and the wireless terminals communicating with the second access point, wherein said second data frames are used in the data transmission between the second access point and the wireless terminals communicating with the second access point,

the first and the second data frames comprise at least one control field and data field, from said data field time slots are allocated for the communication of data transmission connections, and in which wireless data transmission system one or more channel frequencies are used in the transmission and reception of the data frames, wherein each data transmission connection is allocated one of said channel frequencies,

characterized in that also in the method a first starting point and a second starting point are determined from said data field, a first allocation strategy is determined, in which the allocation of the time slots of the data field is started from said first starting point of the data field, and a second allocation strategy is determined, in which the allocation of the time slots of the data field is started from said second starting point of the data field, and

information on the allocation strategy used in the data frame is attached to the data frame, and the transmission and reception of the first data frames is synchronized with the transmission and reception of the second data frames wherein at the first access point, the allocation strategy of the second data frames is examined, and that allocation strategy which is not used in the second data frames is selected for the first data frames.

**Application:**

(Claim 1) A method for implementing a multimedia messaging service between a

wireless terminal that communicates with a communication network over a radio path

and a server, the method comprising the steps of:

- Receiving and storing a multimedia message addressed to the wireless terminal

at the server, said multimedia message comprising at least one multimedia component,

- <u>Storing information on at least one property of the wireless terminal in the</u>

<u>server, characterized in that the method further comprises determining if there is any</u>

<u>component of the multimedia message which the wireless terminal can handle</u>

<u>according to the stored information on at least one property of the wireless terminal,</u>

wherein <u>if there exists one or more such component(s), they are selected for</u>

<u>transmission and transmitted to the wireless terminal.</u>

It was clearly that the patent '915 discloses a wireless/radio system examines the

traffic, when a traffic is detected then a connection is examined and selected [see

abstract]. In order to transmit and receive the multimedia data, the wireless terminal

examines the control field, data field, address (i.e.: the properties or the wireless nodes)

and other information for the connection set up. Thus, the Double Patent rejection is

appropriate.

Furthermore, there is no apparent reason why applicant was prevented from

presenting claims corresponding to those of the instant application during prosecution of

the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158

USPQ 210 (CCPA 1968). See also MPEP § 804.


### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-52 are rejected under 35 U.S.C. § 103 as being unpatentable over Aquilon et

al [Aquilon 6,738,800 B1] in view of Kovacs et al [Kovacs 6,542,819 B1].

4.       As per claim 1, Aquilon discloses a method for implementing a multimedia

messaging service between a wireless terminal that communicates with a

communication network over a radio path and a server [Aquilon, multimedia messages,

col 2 lines 25-35; Internet, col 1 lines 15-24; radio link, col 5 lines 16-33], the method

comprising the steps of:

        - Receiving and storing a multimedia message addressed to the wireless terminal

at the server, said multimedia message comprising at least one multimedia component,

said multimedia message comprising at least one multimedia component [Aquilon, PC-

Palm-based client, message with text and image components, col 7 lines 1-11].

        However Aquilon does not detail

        - Storing information on at least one property (i.e.: name, identifier, address,

protocol) of the wireless terminal in the server, characterized in that the method further

comprises determining if there is any component of the multimedia message which the

wireless terminal can handle according to the stored information on at least one

property of the wireless terminal, wherein if there exists one or more such component,

they are selected for transmission and transmitted to the wireless terminal.

        A skilled artisan would have motivation to improve the communication between

multimedia server and wireless client and found Kovacs teaching.

        Kovacs discloses a geolocation of mobile devices wherein the mobile device

characterized by processing means combining [Kovacs, streetname database, a

location database, a place database, col 5 lines 47-col 6 line 12, Fig 1], in case more than one position information sources are selected by the selected means, the corresponding position information [Kovacs, col 9 lines 3-8].

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the technique of using the property information such as streetname, place or location which stored in database and transmit via the wireless device as taught by Kovacs into Aquilon's apparatus in order to utilize the multimedia message. Doing so would provide a certain information to determine the location of a particular wireless client and service with a requested quality based on the stored information on the system.

5.      Claims 19,35,43 contain the similar limitations set forth of apparatus claim 1. Therefore, claims 19,35,43 are rejected for the similar rationale set forth in claim 1.

6.      As per claims 2,20,44 Aquilon-Kovacs disclose selecting at least one bearer for transmission of the selected component(s) of the multimedia message as inherent feature of ISDN connected MUA client [Aquilon, col 7 lines 47-65].

7.      As per claims 3,21 Aquilon-Kovacs disclose the selection of at least one bearer is performed in the wireless terminal as inherent feature of ISDN connected MUA client and PC-palm-based client [Aquilon, col 7 lines 47-65].

8.    As per claims 4,22,36,45 Aquilon-Kovacs disclose transmitting a notification

message to the wireless terminal comprising information about at least one property of

said at least one multimedia component [Kovacs, streetname database, a location

database, a place database, col 5 lines 47-col 6 line 12, Fig 1].


9.    As per claims 5,23 Aquilon-Kovacs disclose the selection of a component of a

multimedia message for transmission is performed in the server [Aquilon, email server,

col 6 lines 16-27].


10.    As per claims 6,24,37,46 Aquilon-Kovacs disclose information on at least one

property of the wireless terminal is changed to prevent or allow the transmission of at

least one component of the multimedia message as inherent feature of chang or update

the property information [Kovacs, streetname database, a location database, a place

database, col 5 lines 47-col 6 line 12, Fig 1.


11.    As per claims 7,25,47 Aquilon-Kovacs disclose said information on the properties

of the wireless terminal comprises information on the *available storage capacity* of the

wireless terminal [Aquilon, status indicator of available, col 8 lines 41-56; Kovacs,

resource available in the mobile network, col 21 lines 45-49]


12.    As per claims 8,26,48 Aquilon-Kovacs disclose said information on the properties

of the wireless terminal comprises information on the capability of the wireless terminal

to process multimedia components of a particular type [Aquilon, text, video, voice, col 4

lines 8-34].

13.     As per claims 9,27,49 Aquilon-Kovacs disclose the capability of the wireless

terminal to process multimedia components is defined on the basis of the hardware

properties of the wireless terminal and/or the properties of the *programs installed* in the

wireless terminal [Aquilon, WAP phones, col 1 lines 25-45; PC-palm-based client, col 5

lines 17-33].

14.     As per claims 10,28,38 Aquilon-Kovacs disclose a maximum time of validity is

defined for the information on the properties of the wireless terminal stored in said

server as a design choice of set up a time/date field [Aquilon, a time/date field, col 7

lines 1-24]

15.     As per claims 11,50 Aquilon-Kovacs disclose a multimedia message addressed

to the wireless terminal and comprising at least one multimedia component, is received

at the server and a *notification message* is transmitted to the wireless terminal to

indicate that a multimedia message has arrived [Aquilon, notify the recipient, col 6 lines

33-40], characterized in that in the method it is examined (i.e.: mapping) whether

information on the properties of the wireless terminal in question is stored in the server

[Aquilon, mapping of the first structure, col 5 lines 1-15], wherein, if said information is

not stored in the server, said notification message is supplemented with a request to

*update the properties* of the wireless terminal, wherein information on the properties of

the wireless terminal is transmitted from the wireless terminal to the server [Kovacs,

parameters unit is matched or correctly updated, col 3 lines 54-67].

16.     As per claim 12, Aquilon-Kovacs disclose examined whether said information on

the properties of the wireless terminal stored in the server is valid, wherein if said

information is not valid, said *notification message* is supplemented with a request to

update the properties of the wireless terminal [Aquilon, notify the recipient, col 6 lines

33-40].

17.     As per claims 13,31 Aquilon-Kovacs disclose said property information stored in

the server is used as the property information of the wireless terminal if the sever does

not receive a reply from the wireless terminal to said property update request as

inherent feature of updating process [Kovacs, parameters unit is matched or correctly

updated, col 3 lines 54-67].

18.     As per claims 14,29,32 Aquilon-Kovacs disclose a connection set-up request

message is transmitted from the wireless terminal to set up a connection for

transmission of at least one multimedia component of a multimedia message addressed

to said wireless terminal, characterized in that in the method it is examined whether said

*notification message* contains a request to update the properties of the wireless

terminal, wherein information on the properties of the wireless terminal is transmitted

from the wireless terminal to the server in said connection set-up request [Aquilon,

notify the recipient, col 6 lines 33-40].

19.    As per claims 15,33,42 Aquilon-Kovacs disclose a WAP terminal is used as a

wireless terminal and that a multimedia message service centre (MMSC) is used as a

server [Kovacs, mobile multimedia middleware, col 1 lines 10-17; a broadcast server 6,

col 5 lines 47-65, Fig 1].

20.    As per claims 16,34,52 Aquilon-Kovacs disclose a connection set-up request is

transmitted from the wireless terminal to set up a connection for the transmission of at

least one multimedia component of a multimedia message addressed to said wireless

terminal, characterized in that the connection set-up message used is a Uaprof

information transmission message according to WAP specifications [Aquilon, WAP

phones, col 1 lines 25-45], and that the header field is supplemented with a profile-diff

header field, if the connection set-up message is supplemented with information on the

properties of the wireless terminal, or the header field is supplemented with a profile

header field if the connection set-up message is not supplemented with information on

the properties of the wireless terminal [Aquilon, header, col 7 lines 1-24].

21.    As per claim 17, Aquilon-Kovacs disclose those components of the multimedia

message specified in the property information of the receiving wireless terminal stored

in the multimedia messaging system are transmitted *without* a transmission request

being transmitted from the wireless terminal as inherent feature of multimedia message

[Aquilon, col 2 lines 25-42].


22.     As per claims 18,41 Aquilon-Kovacs disclose a transmission request is

transmitted from the wireless terminal to transmit such multimedia message

components which have *not* been specified in the property information of the receiving

wireless terminal stored in the multimedia messaging system as inherent feature of

multimedia message [Aquilon, col 2 lines 25-42].


23.     As per claim 51, Aquilon-Kovacs disclose the wireless terminal is a WAP terminal

or mobile node [Aquilon, WAP phones, col 1 lines 25-45].


24.     As per claims 30,40 Aquilon-Kovacs disclose means for examining the validity of

said property information of the wireless terminal stored in the server, and means for

attaching a request to update the properties of the wireless terminal to said notification

message [Kovacs, parameters unit is matched or correctly updated, col 3 lines 54-67].


25.     As per claim 39 Aquilon-Kovacs disclose interface means (51, 52, 53) for

receiving a multimedia message addressed to the wireless terminal, which multimedia

message comprises at least one multimedia component, and means (18, 15, 12) for

forming a *notification message* for transmission to the wireless terminal to indicate that

a multimedia message has arrived, characterized in that the server also comprises

means to examine whether information on the properties of the wireless terminal in

question is stored in the server, control unit means (55) for attaching a request to

*update* the properties of the wireless terminal to said notification message, and means

(MPLI, RF, ANT) for receiving information on the properties of the wireless terminal at

the server [Aquilon, notify the recipient, col 6 lines 33-40].


Any inquiry concerning this communication or earlier communications from the
examiner should be directed to examiner Thong Vu, whose telephone number is (703)-
305-4643.
The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.
        If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, *Jack Harvey*, can be reached at (703) 305-9705.
        Any inquiry of a general nature or relating to the status of this application should
be directed to the Group receptionist whose telephone number is (703) 305-9700.
        Any response to this action should be mailed to: Commissioner of Patent and
Trademarks, Washington, D.C. 20231 or faxed to :
                        After Final     (703) 746-7238
                        Official:          (703) 746-7239
                        Non-Official   (703) 746-7240
        Hand-delivered responses should be brought to Crystal Park 11,2121 Crystal
Drive, Arlington. VA., Sixth Floor (Receptionist).

*Thong Vu*
*Patent Examiner*
*Art Unit 2142*